

Attorney Docket: 061047-0264493  
Client Reference: AUTH-II

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION of:

Confirmation Number: 9326

SUDIA *ET AL.*

Application No.: 09/870,584

Group Art Unit: 2435

Filed: June 1, 2001

Examiner: B. W. Dada

Title: METHOD FOR SECURELY USING DIGITAL SIGNATURES IN A COMMERCIAL  
CRYPTOGRAPHIC SYSTEM

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated April 16, 2010, Applicant hereby provisionally elects Group I, which includes claims 1, 18-21, 72-78, and 116-131. This response to the restriction requirement is made with traverse.

At the outset, on a technical issue, the Restriction Requirement refers in paragraph 1 to Group I as including claims 1, 18-21, 72-78 and 118-131 and Group II as including claims 79-84 and 109-117. Applicant notes that claims 116 and 117 in Group II depend from claim 1 in Group I. Accordingly, Applicant submits that Group I should properly include claims 1, 18-21, 72-78, and 116-131.

On the merits, MPEP § 808.02 states: "..., the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required." (Underlining emphasis added.) Furthermore, MPEP § 803 states: "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to

independent or distinct inventions.” (Underlining emphasis added.) It is respectfully submitted that it is clear from these MPEP sections that it is PTO policy that the entire application must be searched and examined, regardless of the presence of independent or distinct inventions, if no serious burden exists. It is respectfully submitted that the Examiner has not established that a serious burden exists per MPEP § 808.02, as the entire application can be searched and examined without a serious burden **as it already has been many times**. The Restriction Requirement has not stated any reasons for why there would be a serious burden if there was no restriction.

**This application was filed June 1, 2001, and thus has been pending almost 10 years.** Moreover, Applicant presented currently pending claims 79-84 and 109-115 on July 5, 2005 and the Examiner has searched and examined those claims. **In fact, the Examiners in this case have at least examined them eight (8) times over the last almost five (5) years, and hopefully performed an equal number of searches.** Presumably, the Examiners followed the directives of MPEP Chapters 800 and 900, including the sections discussed above, in formulating and conducting the search. If the Examiners did not follow those directives, Applicant should not now be disadvantaged thereby and have the time to prosecute its claims extended.

Further, a Final Action issued in this case on January 8, 2008. Thus, Applicant submits that per the last sentence of 37 C.F.R. §1.142(a), a requirement to restrict is no longer permitted.

Thus, Applicant respectfully submits there is not a serious burden to examine the present claims, as the Examiner already has done so and would search essentially the same art in any event. Moreover, there is absolutely no reason to issue a restriction requirement this late in prosecution; nothing has significantly changed over the last 5 years and 8 Office Actions to merit restriction now and, indeed, Applicant submits it is not even permitted. A requirement to elect only a subset of the pending claims now is materially prejudicial to Applicant as it has spent significant resources to prosecute all the present claims. Moreover, electing only a subset of the pending claims materially prejudices Applicant's patent term as there is little to no chance that the unelected claims would be examined and granted in a divisional application in the same or shorter time than the elected claims in this application.

MPEP § 808.02 also states: “The examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (c) A

different field of search.” The Examiner contends that the inventions of Groups I and II have acquired a separate status in the art as shown by their different classification.

Class 713, subclass 156 (for Group I) relates to subject matter wherein a single source confirms the legitimacy of a computer on the network or provides logon authorization, wherein the single source provides digital information attesting to a network computers legitimacy. Further, class 380, subclass 282 (for Group II) relates to subject matter providing supervision or control of a signal necessary for encryption or decryption, wherein the manner of sending or receiving the cryptographic key is detailed, distribution of a key is from a single source to plural distributed stations, and a distributed key is protected by a public key algorithm.

Applicant finds no legitimate reasons or coherent rationale for classifying Groups I and II under their respective classes and subclasses. For example, without arguing for a particular classification, there appears to be nothing about the class 380, subclass 282 definition regarding “activating a public key in a hardware device” of Group II. Moreover, there is nothing about class 380, subclass 282 that would not commend classification of Group I in the same class and subclass. Similarly, without arguing for a particular classification, there appears to be nothing about the class 713, subclass 156 definition regarding “a public key system including utilization and secrecy of a public key” of Group I. Moreover, there is nothing about class 713, subclass 156 that would not commend classification of Group II in the same class and subclass.

Therefore, Applicant respectfully objects to the conclusion that Groups I and II each have acquired a separate status in the art as shown by their different classification. Accordingly, the restriction requirement is improper as Applicant cannot discern Examiner’s choice to classify Group I separately from Group II and thus cannot form the basis for the requirement to restrict as asserted in the Restriction Requirement.

If this Restriction Requirement is not withdrawn, Applicant demands that the Examiner withdraw the previous Office Actions and its rejections of the claims (or otherwise Examiner’s position is inconsistent). Moreover, if this Restriction Requirement is not withdrawn, Applicant expressly withdraws all arguments previously made regarding any and all claims that are not elected.

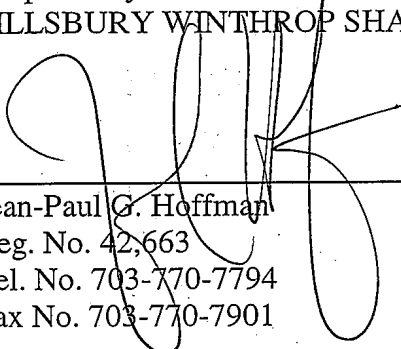
Applicant also notes that the U.S. Patent Office would be required to allow non-elected claims if presented in a divisional application filed according the restriction requirement, over

this application. No double patenting rejection would be available and the term of subsequent divisional applications may be longer than the present application due to, for example, patent term extensions. Applicant expressly takes no position on whether the groups of claims are patentably independent or distinct from one another.

Reconsideration and withdrawal of the Restriction Requirement are respectfully requested and all claims be continued to be examined.

Should any fees be due, please charge them to our deposit account no. 03-3975, under our order no. 061047/0264493. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced deposit account.

Respectfully submitted,  
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